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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/881,678	06/18/2001	Albrecht Schneider	P06568US01/MP	7203

881 7590 09/12/2003

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EXAMINER

WILLIAMS, KEVIN D

ART UNIT	PAPER NUMBER
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2854

DATE MAILED: 09/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Applicati n No.

09/881,678

Applicant(s)

SCHNEIDER, ALBRECHT

Examiner

Kevin D. Williams

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 12-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12,13 and 18-27 is/are rejected.
- 7) ☒ Claim(s) 14-17 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT-Rule-17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the counter-support fixed in place on the punch holder of a punch press must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 27 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification does not describe the counter-support being fixed in place on a punch holder of a punch press. The examiner is unable to ascertain the scope of the claim, therefore prior art will not be applied to the claim.

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***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 12, 20, 21, 25 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Hirate (US 5,775,215).

Hirate teaches an apparatus for marking a sheet-shaped workpiece comprising at least one marking tool 23 and at least one counter-support 25 located opposite the marking tool, the apparatus being configurable with the workpiece disposed between the marking tool and the counter support, the marking tool having a tool tip which can be pressed onto or into a marking surface of the workpiece against a restoring force of a marking tool elastic element, the marking tool being fixed in place on a punch holder 3 of a punch press or a holder of a workpiece support table of a punch press, where the counter-support 25 can be fixed in place relative to the workpiece and disposed on a side of the workpiece opposite the marking surface, the counter-support 25 being fixed in place on a workpiece support table 5 of a punch press, an adjustable support 3 associated with the marking tool by means of which the tip and/or the prestress of its restoring spring can be adjusted, the tip capable of penetrating the surface of the workpiece to a predetermined depth to inscribe a mark, the counter-support 25 being aligned with the marking tool 23 and can be fixed in place on the punch holder or the support table 5, and the counter-support being fixed in place on a punch holder of a

punch press and the marking tool being fixed in place on a workpiece support table of the punch press.

5. Claims 12, 13, 20 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Andou (US 5,474,319).

Andou teaches an apparatus for marking a sheet-shaped workpiece comprising at least one marking tool 15 and at least one counter-support 21 on the side of the workpiece located opposite the marking tool, the counter-support including at least one rotatable support roller 21 or support ball for the movable support of the workpiece, the marking tool having a tool tip which can be pressed onto or into the workpiece against a restoring force of a marking tool elastic element 7, the marking tool being fixed in place on a punch holder 38 of a punch press or the holder at the workpiece support table of a punch press, where the counter-support can be fixed in place on the other side of the workpiece, an adjustable support 45 associated with the marking tool by means of which the position of the tool tip and/or the prestress of its restoring spring can be adjusted, the counter-support 21 being aligned with the marking tool 15.

6. Claims 12, 20, 22, 23 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Rohr (US 5,188,047).

Rohr teaches an apparatus for marking a sheet-shaped workpiece comprising at least one marking tool 78 and at least one counter-support 69 located opposite the marking tool, the apparatus being configurable with the workpiece 10 disposed between the marking tool and the counter support, the marking tool having a tool tip which can be pressed onto or into a marking surface of the workpiece against a restoring force of a

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marking tool elastic element 76, the marking tool being fixed in place on a punch holder 77 of a punch press or a holder of a workpiece support table of a punch press, where the counter-support 69 can be fixed in place relative to the workpiece and disposed on a side of the workpiece opposite the marking surface, an adjustable support 77 associated with the marking tool by means of which the tip and/or the prestress of its restoring spring can be adjusted, the marking tool 78 comprising an ink point comprising a ball point, a roller ball point, a felt tip, or a grease pencil, the counter-support 69 being aligned with the marking tool 78.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirate in view of Canning (US 5,393,707).

Hirate teaches the claimed invention but does not mention the shape of the tool tip or from what material the tool tip is made.

Canning teaches a marking apparatus comprising a diamond tool tip 15 of conical shape.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Hirate to have the diamond tip as taught by Canning because of the extreme durability of diamond.

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9. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Andou in view of Sawa (US 5,344,243).

Andou teaches the claimed invention except for the tool tip being selected from the group consisting of diamond, boron nitride, or a hard alloy.

Sawa teaches a marking apparatus comprising a tool tip being selected from the group consisting of diamond, boron nitride, or a hard alloy (Abs.). Sawa teaches the advantage of printing at high speeds with a tool tip made from a hard alloy.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Andou to have the tool tip as taught by Sawa in order to produce quality prints at high speeds.

10. Claims 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirate in view of Rohr (US 5,188,047).

Hirate teaches the claimed invention except for the tool tip comprising a ball point, a roller point, a felt tip, or a grease pencil.

Rohr teaches a marking apparatus comprising a tool tip comprising a ball point, a roller point, a felt tip, or a grease pencil (78).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Hirate to have the writing utensil as taught by Rohr, in order to mark workpieces with identifying indicia that does not damage the surfaces of the workpieces.

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11. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hirate in view of Keller (US 6,164,203).



Hirate teaches the claimed invention except for the marking tool comprising plastic or brass.

Keller teaches a marking apparatus comprising plastic or brass (col. 12, line 44).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Hirate to have the marking apparatus comprise plastic as taught by Keller, in order to utilize an inexpensive yet durable material.

### ***Response to Arguments***

12. Applicant's arguments filed 6/20/2003 have been fully considered but they are not persuasive.

Applicant argues that Hirate fails to teach or suggest that the marking tool 79 is inserted into a punch press. The examiner does not rely on element 79 as a teaching of a marking tool. The examiner relies on element 23 as a teaching of a marking tool.

Applicant argues that the term "marking tool" has a specific meaning such that one of ordinary skill in the art would not refer to a punch as a marking tool. The term "marking tool" is used very broadly to define a myriad of devices that mark on other objects. As evidence, see US 2002/0110657 to Scarborough who describes a pencil as a marking tool in paragraph [005]. Also, see US 2003/0127797 to Katz who describes a printing device as a marking tool. The above references demonstrate the wide array of devices that are described as marking tools in the printing art.

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Applicant further argues that to refer to a punch as a marking tool would be repugnant to the common everyday meaning of the term as recognized by one of ordinary skill in the art. The examiner cannot give the term "marking tool" a meaning so

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specific that it would eliminate a punch from being encompassed by that meaning when other references in the printing art describe a wide range of devices as marking tools.

The examiner must give the term "marking tool" its broadest reasonable interpretation.

Moreover, applicant himself has described the marking tool in the present invention as a diamond tip engraving device and also as a felt tip writing pen. If these two devices can both be considered as marking tools, then a punch of a punch press cannot be considered to be repugnant to the common everyday meaning of the term as recognized by one of ordinary skill in the art.

Applicant argues that Hirate fails to teach or suggest a counter-support as that term would be understood by one of ordinary skill in the art. The term counter support is a term of art and would be understood by one of ordinary skill in the art as a supporting device that is counter to another device. Hirate teaches this feature as element 25.

Applicant argues that Hirate fails to teach a marking tool comprising a tip capable of penetrating the surface to a predetermined depth to inscribe a mark. The punches 25 are capable of penetrating the surface of the workpiece to a predetermined depth to inscribe a mark. The examiner takes the position that deciding before hand to penetrate the surface of the workpiece to a depth equal to the thickness of the workpiece meets the limitation of penetrating the workpiece to a predetermined depth to inscribe a mark.

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Also, the claim as recited only requires a device that is **capable** of penetrating the surface to a predetermined depth.

Applicant argues that Rohr does not teach a punch press. Applicant further argues that the sewing machine of Rohr is not equivalent to the claimed punch press. The examiner does not rely on the sewing machine as a teaching of a punch press, but rather the marking device 16,72. The examiner's position is that the marking device of Rohr is an equivalent to the punch press as claimed by applicant. Applicant has not claimed any specific structure of the punch press, but merely an inferential recitation of a punch press. The examiner is unable to give the recitation of a punch press any structural weight beyond the mere recitation, because applicant has not claimed any structural features of the punch press. Moreover, according to applicant's disclosure, a diamond tip for engraving can be inserted into the punch press **and** a felt tip writing pen can also be inserted into the punch press. It appears that devices which function similarly to punch presses, namely devices having the ability to position a marking tool on or into a workpiece against the force of an elastic member, are equivalents to the punch press as claimed by applicant. It is not conventional for "punch presses" to incorporate felt tip writing pens as marking tools. Therefore, applicant's own invention uses the term "punch press" in a manner that is repugnant to its ordinary meaning in the art. Accordingly, the examiner cannot limit the acceptable prior art to references that specifically use the terms "punch press." Rather, the examiner must look to the structural limitations of the claim and give the term "punch press" its broadest reasonable interpretation. Rohr meets the structural limitations of the claim.

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Applicant argues that Canning is nonanalogous art and that one skilled in the art looking to improve the Hirate device would not be inclined to look to the Canning

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reference. Hirate teaches a device for marking on sheet-shaped workpieces. Canning teaches a marking tool for inscribing workpieces. One skilled in the art looking to mark on sheet-shaped workpieces would certainly be inclined to look to the Canning reference for its apparent advantages.

Applicant argues that Rohr is nonanalogous art and that one skilled in the art looking to improve the Hirate device would not be inclined to look to the Rohr reference. Hirate teaches a device for marking on sheet-shaped workpieces. Rohr also teaches a device for marking on sheet-shaped workpieces. One skilled in the art looking to mark on sheet-shaped workpieces would certainly be inclined to look to the Rohr reference for its apparent advantages.

Applicant argues that Keller is nonanalogous art and that one skilled in the art looking to improve the Hirate device would not be inclined to look to the Keller reference. Hirate teaches a device for marking on sheet-shaped workpieces. Keller also teaches a device for marking on sheet-shaped workpieces. One skilled in the art looking to mark on sheet-shaped workpieces would certainly be inclined to look to the Keller reference for its apparent advantages.

***Allowable Subject Matter***

13. Claims 14-17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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The following is a statement of reasons for the indication of allowable subject matter:

The primary reason for the indication of the allowability of claim 14 is the limitation of the marking tool including rotatable support rollers or support balls seated in an elastically spring-loaded manner for supporting the workpiece in combination with the other claimed subject matter.

***Conclusion***

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin D. Williams whose telephone number is (703)

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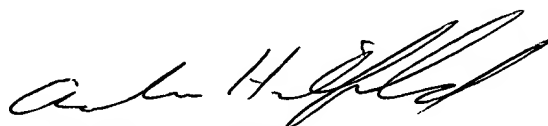
305-3036. The examiner can normally be reached on Monday - Friday, 8:30am - 6:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew H. Hirshfeld can be reached on (703) 305-6619. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

KDW



ANDREW H. HIRSHFELD  
SUPERVISORY PATENT EXAMINER  
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